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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,262	11/08/2001	Annette Bistrup	UCAL 107DIV	4699
	7590	11/28/2003	EXAMINER	
Paula A. Borden Bozicevic, Field and Francis LLP Suite 200 200 Middlefield Road Menlo Park, CA 94025			MORAN, MARJORIE A	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/007,262	Applicant(s) BISTRUP ET AL.	
	Examiner Marjorie A. Moran	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-20, 22-24 and 30-41 is/are pending in the application.
4a) Of the above claim(s) 18-20, 22-24 and 33-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 17 and 30-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 November 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>attached</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>11/8/01</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Applicant's election with traverse of Group I, claims 16, 17, and 30-32, in a response filed 8/15/03, is acknowledged. The traversal is on the ground(s) that a search and examination of all claims would not be a serious burden to the examiner. This is not found persuasive because claims directed to methods of administration or treatment (i.e. Group II) require a search not required for an in vitro method (i.e. Group I). Also, methods of administration and treatment require consideration of issues under 112, first paragraph (e.g. enablement) which are different from issues to be considered for an in vitro method. In addition, it is noted that as search for any single Group requires a search of both nonpatent literature and foreign patents and well as a search of US patents. For all of these reasons, the examiner maintains that search and consideration of the claims of both Groups I and II would be a serious burden.

The requirement is still deemed proper and is therefore made FINAL.

Claims 18-20, 22-24, and 33-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the response filed 8/15/03.

An action on the merits of elected claims 16-17 and 30-32 follows.

Information Disclosure Statement

The IDS filed 11/8/01 has been considered in full.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-17 and 30-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 recites enzymes termed "glycosyl transferase-3" and "KSGal6ST" in lines 4-5. While the specification does provide a written description for enzymes to which these names are assigned, it is noted that proteins and enzymes may be assigned a variety of names in the art, depending on the user, place of use, etc. of the protein. Further, a protein "name" may be used to refer to a variety of proteins with different sequences, which albeit similar, are not identical. As it is unclear what specific protein(s) applicant intends, the metes and bounds of the claim are unclear, therefore claim 16 is indefinite. Claims 17 and 31-32 fail to correct the indefiniteness of claim 16 and are therefore also indefinite. Claim 30 identifies a GST-3 protein as one encoded by a recited SEQ ID NO, and is not indefinite with regard to a glycosyl transferase-3. However, claim 30 fails to identify KSGal6ST, and is therefore still indefinite.


Conclusion

Claims 16-17 and 30-32 are rejected; claims 18-20, 22-24, and 33-41 are withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (703) 305-2363. The examiner can normally be reached on Monday to Friday, 7:30 am to 4 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (703) 308-4028. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3524.


MARJORIE MORAN
PATENT EXAMINER

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